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| APPLICATION NO.                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|-----------------------|------------------|
| 10/817,622                       | 04/02/2004  | Joseph R. Garlich    | 224297                | 2375             |
| 23460                            | 7590        | 10/26/2007           | EXAMINER              |                  |
| LEYDIG VOIT & MAYER, LTD         |             |                      | JONES, DAMERON LEVEST |                  |
| TWO PRUDENTIAL PLAZA, SUITE 4900 |             |                      |                       |                  |
| 180 NORTH STETSON AVENUE         |             |                      | ART UNIT              | PAPER NUMBER     |
| CHICAGO, IL 60601-6731           |             |                      | 1618                  |                  |
|                                  |             |                      | MAIL DATE             | DELIVERY MODE    |
|                                  |             |                      | 10/26/2007            | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/817,622             | GARLICH ET AL.      |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | D. L. Jones            | 1618                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 August 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,6,7,12,17-20,23,25,27,29,31,33,35-37,75-77 and 79-104 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) Claim(s) 1,2,6,7,17-20,23,25,27,29,31,33,37,75-77,79-82,84,86-95 and 100-104 (all claims in-part) is/are allowed.
- 6) Claim(s) 12,35,36,83,85 and 96-99 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

**Continuation of Disposition of Claims:** Claims withdrawn from consideration are 1, 2, 12, 17-20, 23, 25, 27, 31, 29, 35-37, 79, 82, 83, 86, 87, 90, 92, 94, 96, 97, 100, 103, and 104(all claims in-part).

## ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 8/20/07 wherein claims 1, 12, 76, and 77 were amended; claims 3-5, 8-11, 13-16, 21, 22, 24, 26, 28, 30, 32, 34, 38-74, and 78 were canceled; and claims 79-104 were added.

Note: Claims 1, 2, 6, 7, 12, 17-20, 23, 25, 27, 29, 31, 33, 35-37, 75-77, and 79-104 are pending.

## RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENTS

2. The Applicant's arguments and/or amendment filed 8/20/07 to the rejection of the claims made by the Examiner under 35 USC 112 has been fully considered and deemed persuasive for the reasons set forth below. Therefore, the said rejection is hereby withdrawn.

### **112 First Paragraph Rejection**

The 112 first paragraph rejection is WITHDRAWN because Applicant has amended the claims to overcome the rejection.

### **112 SECOND PARAGRAPH REJECTION**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12, 35, 36, 83, 85, and 96-99 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12, 83, and 85: The claims as written are ambiguous because it is unclear what chemical(s) or type of radiation Applicant is referring to which is compatible with

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the instant invention. The claim as written encompassed any kind of chemical ranging from method to chemotherapeutic compounds, for example. Likewise, the term radiation would encompass a multitude of possible types of radiation that are not necessary compatible with the instant invention. Please clarify the claims in order that one may ascertain what is being claimed.

Claims 35, 96, and 98: The claims are ambiguous because it is unclear what types or groups of hydrolytically cleavable linkages Applicant is referring to which are compatible with the instant invention. Please clarify in order that one may ascertain what is being claimed.

Claims 36, 97, and 98: The claims as written are ambiguous because it is unclear that enzymatically cleavable linkage of groups of linkages are compatible with the instant invention. Please clarify in order that one may ascertain what is being claimed.

#### **ELECTION BY ORIGINAL PRESENTATION**

5. Newly submitted claims 79, 82, 83, 86, 87, 90, 92, 94, 96, 97, 100, and 104 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons. A restriction requirement was made and Applicant elected to prosecute Group III. The restriction was deemed proper and the search was not expanded beyond the elected group.

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 79, 82, 83, 86, 87, 90, 92, 94, 96, 97,

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100, and 104 (*all claims are withdrawn in part*) are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### **ALLOWABLE CLAIMS**

6. Claims 76 and 77 are allowable over the prior art of record for reasons of record in the office action mailed 5/18/07.

7. Claims 1, 2, 6, 7, 17-20, 23, 25, 27, 29, 31, 33, 37, 75, 79, 80-82, 84, 86-95, and 100-104 (*all claims in part*) are allowable over the prior art of record for reasons of record in the office action mailed 5/18/07.

### **WITHDRAWN-IN-PART CLAIMS**

8. Claims 1, 2, 12, 17-20, 23, 25, 27, 31, 29, 35-37, 79, 82, 83, 86, 87, 90, 92, 94, 96, 97, 100, 103, and 104 (*all claims were examined in-part*) are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species. Specifically, the claims are withdrawn-in-part as being directed to the elected invention and other subject matter nor directed to the elected invention. It should be noted that the search was not extended beyond the elected invention.

### **COMMENTS/NOTES**

9. The search has not been expanded beyond Applicant's elected Group III. Group III is directed to a method of inhibiting cell death wherein the cell protection factor is a compound of Formula IV (see the restriction mailed 3/17/06). Thus, the search has not been examined beyond elected Group III, the elected invention.

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10. Applicant is respectfully requested to amend all the independent claims to include elected Group III. Specifically, Applicant is requested to amend all the independent claims to include Formula IV.

11. It should be noted that no prior art has been cited against the instant invention. The claims are distinguished over the prior art of record for reasons of record in the office action mailed 5/18/07.

12. Applicant is respectfully requested to insert the appropriate application number in the blank on page 25, line 5.

13. It is respectfully suggested that Applicant replace 'comprises' with 'has' in claims 17-20 and 86-89.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

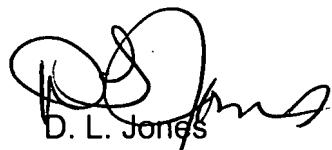
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



D. L. Jones  
Primary Examiner  
Art Unit 1618

October 20, 2007